

REMARKS:

In the Office Action mailed July 21, 2008, the Examiner noted that claims 101-106 are pending in the application, and the Examiner rejected all claims. A Response was filed on November 21, 2008.

An Advisory Action dated December 17, 2008 was issued in response to the Response filed on November 21, 2008.

By this Amendment, claims 101-106 have been amended and claims 107 and 108 are added. Applicants respectfully request that the Examiner consider this Amendment. No new matter has been presented. No new matter has been presented.

A Request for Continued Examination is submitted.

Thus, claims 101-108 are pending in the application. The Examiner's rejections are traversed below, and reconsideration of all rejected claims is respectfully requested.

REJECTIONS UNDER 35 USC §103:

In the Office Action mailed July 21, 2008, the Examiner rejected claims 101-106 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,056,019 (Schultz) in view of U.S. Patent No. 5,201,010 (Deaton) in further view of U.S. Patent No. 4,882,675 (Nichtberger). The Applicants respectfully traverse the Examiner's rejections of the remaining claims.

In the Advisory Action dated December 17, 2008, the Examiner compares the database in Schultz with information of the customer's current cumulative points stored in the customer database of the present application (page 2, second paragraph of the Advisory Action). In doing so, the Examiner asserts that Schultz teaches providing a point balance to a customer via a report.

The status of the rewards of a user in Schultz is only determined at a time set by the central system (see, col. 7, lines 60-67). That is, the report in Schultz is only provided at the same pre-specified period of the system, and does not teach or suggest "sending the customer's current cumulative points stored in the customer database to the terminal... regardless of the customer's request of sending points" in response to "receiving a customer identification information from the terminal and identifying the customer", as recited in claim 101 for example. See also claims 102, 103, 104, 105 and 106 reciting similar features.

In fact, when considering Schultz in its entirety including portions explicitly stating, "Periodically, usually monthly, the consumer history files are used to create statement records 10a ... [which] produces a status report 17 for the consumer 19" (see, col. 8, lines 42-47), Schultz teaches away from "sending the customer's current cumulative points stored in the customer database to the terminal... regardless of the customer's request of sending points" in response to "receiving a customer identification information from the terminal and identifying the customer", as taught by the claimed invention.

The Examiner acknowledges that Schultz fails to teach that "the point balance is sent to the terminal after the customer identification and prior to performing a transaction by the customer" (see at least page 2 of the Advisory Action). Therefore, the Examiner has admitted that "a point sending unit" recited in current claims 101 and 102 and the feature of "sending the customer's current cumulative points" recited in current claims 103-106 is not disclosed in Schultz.

However, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer access their reward coupons as items are being purchased (before the purchase total) based on teachings of Deaton and Nichtberger. Applicants respectfully disagree for the following reasons.

First, the Examiner's modification to Schultz such that the customers access their rewards "before the purchase total" still indicates that there is a transaction (i.e., a purchase) required for providing the report. This is not required by the claimed invention, since the cumulative points are sent in response to "receiving a customer identification information from the terminal and identifying the customer" (see claim 101 for example).

Further, it is apparent that a transaction has already been started, because, in Deaton, the related series of processing is performed at the time when a customer hands a check to a store clerk and a coupon is displayed. Therefore, the claimed feature of "prior to transaction" relevant to the point sending unit has nothing to do with Deaton. Further, since Deaton does not teach or suggest providing the cumulative points prior to a transaction, this feature is not taken into consideration for the Deaton's invention, and therefore, one of ordinary skill in the art would not try to combine Nichtberger with Deaton.

The Examiner again acknowledges that "Deaton teaches that the coupon reward and other incentives are made at the point of sale (POS) terminal", however the Examiner maintains

that it would have been obvious to provide the points "prior to a transaction." The coupon reward in Deaton is displayed on the POS terminal after the commencement of and only in association with a transaction.

Deaton, explicitly states in col. 10, lines 31 – 44:

"... to initiate a check verification request, check reader 121 automatically scans the magnetic ink character recognition (MICR) data printed along the bottom edge of the customer's check and then the store clerk operates the keypad 122 to enter the amount of the check, along with the function code designating check verification. This request is displayed on display 124, and sent, along with data from the check reader 121, to transaction processor 112. The check verification response, including the customer's verification status (such as POSITIVE, NEGATIVE or CAUTION), and marketing information (such as the type of coupon to be dispensed) returned by the transaction processor is then displayed on display 124.

The above-identified operation is also reiterated in the explanation of the program flowchart (see col. 68, lines 13-67, particularly steps 5 - 13 of Deaton).

As can be seen from the above discussion, first, a customer hands his check to a store clerk, then the predetermined series of operations are carried out and only thereafter the coupon is displayed on the terminal. Thus, it is apparent that a transaction has already been started. Meaning, unlike the claimed invention of "prior to performing transactions", Deaton is limited to only subsequent to commencement of a transaction.

The Examiner points to col. 17, lines 30–61 of Nichtberger, on page 7, lines 4 - 8. However, in Nichtberger, a customer inserts a special card into a local coupon distribution and redemption (CDR) unit 20 before the checkout process, the customer selects a coupon according to a request by this customer from the corresponding list displayed on the screen of the CDR unit 20, then the CDR unit 20 stores the selected coupon in a memory thereof. Thereafter, when a checkout process is to be achieved, a cash register terminal searches for goods corresponding to the above selected coupon from among the goods which the customer has purchased, where the cost for the goods is charged to the coupon supplier.

Nichtberger does not disclose or suggest "sending of the customer's current cumulative points stored in the customer database to the terminal prior to performing transactions by the customer based upon the customer identification result", as taught by the claimed invention. Instead, in Nichtberger, a coupon is sent not to a cash register terminal, i.e. a terminal which executes a transaction, but to a CDR.

The cited references do not teach or suggest "regardless of the customer's request of sending points... sends the customer's current cumulative points stored in the customer database to the terminal prior to performing transactions by the customer based upon the customer identification result (emphasis added). See also claims 103-106 reciting "sending" process.

Moreover, Applicants respectfully submit that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. In this case, the Nichtberger system, which is directed to sending the coupon to a CDR which is separate and apart from the terminal, teaches away from sending reward information to the terminal for performing transactions as taught by the claimed invention. This is apparent since Nichtberger requires customers to stand in line before the cash register of the checkout counter (see column 17, line 30) to select the coupon, which is inconvenient for the customers, not practical, and decreases efficiency of a checkout processing. Therefore, in Nichtberger, the cash register terminal stands separate from the CDR.

On page 2 of the Advisory Action dated December 21, 2008, the Examiner asserts that the fact that Nichtberger is not compatible with the design of some conventional system does not equate that the invention is not enabled. However, the CDR being separate and apart from the terminal in the Nichtberger system was pointed out to indicated that, even assuming the Examiner's interpretation of Nichtberger, the same teaches away from sending cumulative points information to the terminal for performing transactions as taught by the claimed invention (i.e., since the information is sent to the CDR which is different from the terminal).

The CDR unit 20 of Nichtberger is dedicated only to provide coupons for customer's selection thereof, which is further indicated by the name "coupon distribution and redemption." Therefore, in Nichtberger, a customer apparently intends to carry out a coupon redemption and inserts his or her card into the CDR so as to watch the coupons (see column 5, lines 4 to 11 and column 11, line 15). In short, a customer requests the display of the coupon information. To this end, Nichtberger does not teach or suggest "sending points... regardless of the customer's request of sending points", as taught by the claimed invention.

It is respectfully submitted that none of the references teach or suggest the claimed "point sending unit" and "sending the customer's current cumulative points... regardless of the customer's request of sending points."

Further, even assuming arguendo that Schultz, Deaton, and Nichtberger did disclose the features discussed by the Examiner, the Applicants respectfully submit that there is no motivation to combine the cited references. The Examiner stated that the combination of the references would be obvious because it allows the customer to take advantage of earned coupons as items are being purchased (before the purchase total) because it allows the customer to take advantage of earned coupons/rewards through their shopping history at the point of sale rather than having to make another trip back to the store or having to remember to bring the physical coupon reward.

Absent hindsight, there is no reason for combining the cited references. For example, while Nichtberger may provide a reason for sending the coupon to a CDR using which a customer selects a coupon, Schultz and Deaton fail to suggest why a person of ordinary skill in the art at the time of the invention would be motivated to incorporate the coupon distribution and redemption such as discussed in Nichtberger. In other words, an attempt to bring in the isolated teaching of Nichtberger into the Schultz and/or Deaton system would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.

Furthermore, in Deaton, it displays the kind of coupons to a store clerk, where the coupons are to be given to a customer (see, column 69, lines 44 to 60). From this point of view, it is apparent that it would be impossible to combine Deaton with each of Shultz and Nichtberger, because Shultz and Nichtberger discuss an invention which is based on providing a coupon to a customer (not a store clerk). Therefore, the Examiner has not established a *prima facie* case of obviousness since there is no teaching, suggestion or motivation to combine Deaton, Shultz and Nichtberger.

Therefore, withdrawal of the rejection is respectfully requested.

NEW CLAIM:

The cited references do not teach or suggest sending of the customer's cumulative points is executed "without requiring receipt of a request for the customer's cumulative points from the customer and in response to said identifying of the customer (claim 107) and "independent and separate from performing of the transactions and in response to receipt of said customer identification information" (claim 108).

Instead, Schultz only refers to periodic reports, Deaton is limited to a coupon only in association to and after a transaction, and Nichtberger refers to sending information to a CDR which is not the terminal for transaction.

Therefore, it is submitted that new claims 107 and 108 are patentably distinguishable over the cited references.

CONCLUSION:

There being no further outstanding objections or rejections, it is respectfully submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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